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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/797,188	02/11/97	DEANGELIS	ROKen-40907

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ART UNIT	PAPER NUMBER
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07/08/98

DATE MAILED:

Response due: October 8, 1998

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/797,188	DeAngelis
Examiner	**Group Art Unit**
Neal Muir	3712

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-151* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-151* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

~~☒ Notice of Draftsperson's Patent Drawing Review,~~ PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required if the application is allowed.

Note the enclosed PTO 948 for other deficiencies.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-151 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-97 of copending Application No. 08/578,210. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a plurality of toy vehicles with control from any of a plurality of controllers with a central station to issue commands.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. Claims 1-151 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-75 of copending Application No. 08/696,263. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a plurality of toy vehicles with control from any of a plurality of controllers with a central station to issue commands.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

4. Claims 89,90,93,94,102 and 103 are, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims state cyclic or simultaneous inquiry of the pads. By such claiming, Applicant asserts that either or both of the cyclic or simultaneous inquiry **is not critical**. By Applicant's admission these concepts are held to not be critical and are considered as such.

The remainder of this action considers the claims as they are understood.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 6-8, 20-22, 61, 62, 144 and 145 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yavetz.

7. Claims 147 and 148 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rosenhagen et al.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1,2,4,5,9,10,14-19,2829,33-39,43-60,86-97,100-103,108-110,129-131,136 and 137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yavetz in view of Stern et al.

Yavetz discloses a toy set with light indicators on the controllers and transmitters for each controller. He lacks a central station for controller input. This is taught by Stern. It would have been obvious to one of ordinary skill in the art to have provided a Yavetz set with a central station, as taught by Stern, in order to save money by only requiring a single transmitter for the set, instead of the many transmitters, one for each controller.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yavetz in view of Stern et al as applied to claim 2 above, and further in view of Rosenhagen et al.

Yavetz, as modified, lacks the provision of any controller being able to control any vehicle, such as is taught by Rosenhagen. It would have been obvious to have provided a Yavetz toy with the ability to control any vehicle, as taught by Rosenhagen, in order to make the "conflict" more of a challenge by enabling a player to "capture" one of more of the "enemy" vehicles.

12. Claims 11-13,23-27,30-32,104-107,138,139,141,150 and 151 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenhagen et al in view of Stern et al.

Rosenhagen lacks the use of central station to reduce transmitters, as is taught by Stern. It would have been obvious to have provided a Rosenhagen set with a central station, as taught by Stern, in order to reduce the number of transmitters required in the set and thereby reduce costs.

13. Claims 140 and 143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenhagen et al in view of Stern et al as applied to claims 139 and 142 above, and further in view of Yavetz.

Rosenhagen is silent regarding whether his vehicle has "active" lights, but this is clearly taught by Yavetz. It would have been obvious to have provided a Rosenhagen set with vehicles with "active" lights, as taught by Yavetz, in order to establish which vehicles were actually in use at any given time.

14. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mabuchi et al in view of Stern et al.

Mabuchi discloses dual wheeled and dual motored toys. The teachings of Stern are used in the same manner, for the same reasons as in the rejection of claim 1 above.

15. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mabuchi in view of Stern et al as applied to claim 40 above, and further in view of Rosenhagen et al.

Mabuchi, as modified, lacks the use of pulse width modulation, such as are taught by Rosenhagen. It would have been obvious to have used a pulse width modulation for control signals in a Mabuchi toy, as taught by Rosenhagen, in order to make use of this more efficient and effective type of remote control signal.

16. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mabuchi et al in view of Stern et as applied to claim 40 above, and further in view of Yang.

Mabuchi, as modified, lacks the use of the last command priority unless over ridden, such as is taught by Yang. It would have been obvious to have provided a Mabuchi toy with last command priority, as taught by Yang, in order to ensure that the toy would continue to do something, or nothing, until properly given a new command.

17. Claims 63-85, 98 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yavetz in view of Stern et al and Yang.

Yavetz lacks the central station and clock generator with signal timing. The teachings of Stern are used in the same manner, for the same reasons as in the rejection of claim 1. Yang also teaches that a toy vehicle set may have a clock generator and signal timing. It would have also been obvious to have provided a Yavetz set with a clock generator and timing signals, as taught by Yang, in order to have sequential control of the output signals thereby preventing signal mixup and degradation of the toys' control. The number of lines used by any system is seen to have been an

obvious choice of design, obvious to one of ordinary skill, to control and enable any chosen communications.

18. Claims 111-128, 132-135, 148 and 149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yavetz in view of Stern et al and Rosenhagen et al.

Yavetz lacks the central station and any controller being able to control any vehicle. The teachings of Stern and Rosenhagen are use din the same manner, for the same reasons, as in the rejection of claim 1 and 3, respectively.

Prior Art

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jacobson discloses a set where plural controllers each control slaved construction vehicles.

Ermrich et al discloses multiple microprocessors for toy train controls.

Any inquiry concerning this communication should be directed to D. Neal Muir at telephone number (703) 308-1206.

DNM
July 6, 1998

D. Neal Muir
Examiner
Art Unit 3712